

Appl. No. 10/706,104  
Docket No. 9118M  
Amdt. dated June 14, 2010  
Reply to Office Action mailed on April 13, 2010  
Customer No. 27752

REMARKS

Claim Status

Claims 18-20, 24-29, 31-32, 34 and 36 are pending in the present application. No additional claims fee is believed to be due.

Independent claims 18, 28, 32, and 34 have been amended to limit the list of retention modifiers.

These amendments are respectfully requested so as to present the rejected claims in better form for consideration on appeal. Despite these amendments, no new matter has been added.

Rejection Under 35 USC § 103(a) over Lawlor (US 6,706,256) in view of La Rochelle (US 4,157,386)

The Office Action rejects claims 18-20, 24-29, 31-32, 34, and 36 under 35 USC 103(a) as being unpatentable over Lawlor in view of La Rochelle.

To establish a *prima facie* case of obviousness under §103, the Examiner has the burden of showing, by reasoning or evidence, that: 1) there is some suggestion or motivation, either in the references themselves or in the knowledge available in the art, to modify that reference's teachings; 2) there is a reasonable expectation on the part of one of ordinary skill in the art that the modification or combination has a reasonable expectation of success; and 3) the prior art references (or references when combined) teach or suggest all the claim limitations. MPEP §2145. Applicants submit that the burden of a *prima facie* case of obviousness has not been met.

Applicants have amended each independent claim to remove pectin and insoluble polymers from the list of retention modifiers. As currently claimed, the oral care composition comprises from about 0.5% to about 20% of a retention modifier, selected from the group consisting of bentonites, shellac, zein, and alkyl vinyl ether-maleic acid or anhydride copolymer and salts thereof, and mixtures thereof. Lawlor and La Rochelle fail to teach or suggest a retention modifier or any of the specific materials in the claims as amended. Therefore, because the prior art references, individually and combined, fail

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to teach or suggest all the claim limitations, a *prima facie* case of obviousness has not been met.

Furthermore, Applicants note that when determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Applicants respectfully contend that the present claim limitations that the composition forms an intact hydrated mass that is visible on 2 to 3 molar or premolar surfaces to greater than 7 molar or premolar surfaces for 5 minutes to 60 minutes after a human subject chews two tablets of the composition for 5 to 30 seconds, brushes his or her teeth with a manual, flat head, soft toothbrush for 30 seconds, expectorates the slurry created from the brushing, and then rinses with 10 ml of water and expectorates again is not taught or remotely suggested by the cited references.

The Examiner has previously relied on this passage in Lawlor: “In order to maximize the effects of such methods it is preferred that the compositions of the present invention are formulated such that they remain in the oral cavity for at least 10 seconds. The methods are improved the longer the composition remains in the oral cavity.” (col 24, lines 36-39). Applicants respectfully argue that a composition retained in the mouth for “at least 10 seconds” along with a generic statement that longer is better is a far and unobvious step from the retention of a composition *for up to 60 minutes, after brushing*. As stated by the Supreme Court in *KSR*, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In addition, La Rochelle’s use of a starch adhesive teaches away from the claimed invention’s limitation of forming a mass that is retained on the teeth for up to 60 minutes. Starch adhesives are cariogenic, while the present compositions as claimed have the limitation of being non-cariogenic. As La Rochelle’s compositions are cariogenic, it only makes sense that La Rochelle would not teach that its compositions should be retained in the teeth for up to 60 minutes. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the

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particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d (BNA) 1130, 1131 (Fed. Cir. 1994). Thus, Applicants assert that a *prima facie* case of obviousness has not been met.

Finally, the Examiner has responded to arguments about the length of time of retention by stating that a preamble does not have any patentable weight. Applicants respectfully assert that the Examiner's statement is misplaced, as the Applicants are referring to actual claim limitations, not a preamble.

Applicants respectfully submit that a *prima facie* case of obviousness has not been made and respectfully request that the rejection be withdrawn and the claims allowed.

In the event that the Examiner disagrees that the pending claims are in condition for allowance, Applicants respectfully request that the current amendments be entered.

#### Conclusion

This response represents an earnest effort to place the present application in proper form. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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